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1773

Serial No. 09/658,289

13DV13218

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#3

In re Application of

Matthew D. Saylor, et al.

:Group Art Unit: 1773

Serial No. 09/658,289

:Examiner: Ramsey Zacharia

Filed: September 8, 2000

:Response to Paper No. 2

For METHOD FOR THE APPLICATION
OF A WATER BORNE, SPRAYABLE
EROSION COATING MATERIAL

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ORIGINALLY FILED

RESPONSE TO RESTRICTION REQUIREMENT UNDER 35 U.S.C. 121

Assistant Commissioner for Patents,
Washington, DC 20231

S I R:

This is in response to the Office Action dated April 24, 2002.

Claims 1-21 remain pending in the present application.

Restriction has been required between (I) claims 1-4, drawn to a composition, (II) claims 5-9, drawn to a coated article, and (III) claims 10-21, drawn to a method of coating. This restriction requirement is respectfully traversed.

The Examiner states that inventions I and II are related as combination and subcombination. The Examiner further states that the inventions are distinct because the combination as claimed does not require the particulars of the subcombination as claimed and the subcombination has a

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separate utility such as a precursor to a self-supporting film. However, in this case, the subcombination is a "sprayable erosion coating mixture for protecting aircraft and aircraft engine components." It is respectfully submitted that such a coating mixture would not have a separate utility as the precursor for a self-supporting film. Moreover, even if the erosion coating mixture of claims 1-4 were used as a precursor, it would still have an erosion resistant utility. Thus, the required two-way distinctness has not been shown.

The Examiner states that inventions I and III are related as product and process of use and that the product can be used in a materially different process such as for coating a component that is not part of an aircraft or aircraft engine and/or applying the coating by dipping or brushing. The Examiner also states that inventions II and III are related as process of making and product made and that the product can be made by a materially different process. Applicant respectfully traverses these restriction requirements on the basis that the requisite serious burden on the Examiner set forth in MPEP § 803 does not appear to exist. Although the inventions may have separate classifications, applicant believes that the inventions are so closely related that the field of search necessary to properly search either invention would encompass the other invention as well. Because a different field of search is not required, there is no serious burden as required by MPEP § 803.

For these reasons, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Applicant provisionally elects invention I, claims 1-4 for further prosecution. The remaining claims will be retained pending resolution of the traversal.

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An action on the merits is awaited.

Respectfully submitted,

5/24/02

Date

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